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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

STANLEY B. MILLER III et al)
Serial No. 09/768,016)
Filed January 23, 2001)
ACID-GAS ABSORBING TABLET)
AND METHOD OF USE)

Art Unit 1615

Examiner Susan T. Tran

19/Reply
Brief (3)

APPELLANTS' REPLY BRIEF

This is in reply to the Examiner's Answer of
September 9, 2003.

Set
10-23-03

On page 3 of the Examiner's Answer, the Examiner set forth the rejection of claims 3-6 and 38-46 as being unpatentable over the Tuma et al patent 6,146,446. The reasons for the rejection given in the Examiner's Answer are substantially the same as set forth in the final rejection. In this respect, appellants quoted this portion of the final rejection in the first full quote on page 6 and the last full quote starting at the end of page 5 of Appellants' Brief. Appellants fully answered the Examiner's rejection starting at the last full paragraph on page 7 of Appellants' Brief and continuing on to about the middle of page 11 of Appellants' Brief. It is to be noted that in the appellants' treatment as set forth on pages 7-11 of Appellants' Brief, claims 3, 38 and 39 were treated in specific detail to show how they defined over the Tuma patent. The Examiner did not comment on appellants' reasoning but merely lumped all of the claims together.

At this point it is to be noted that claim 38 was not treated by the Examiner in the final rejection, as stated in the first full paragraph on page 5 of Appellants' Brief. Claim 38 was rejected by the Examiner for the first time on page 3 of the Examiner's Answer, after appellants set forth reasons why claim 38 defined over Tuma.

The Examiner rejected claims 7, 10-12 and 28-37 under 35 USC 103 as being unpatentable over Tuma and Osborne, starting at page 4 of the Examiner's Answer. In the rejection the Examiner set forth reasons why claims 7, 10-12 and 28-37 were unpatentable over the references in the three paragraphs starting at the second last full paragraph on page 4 of the Examiner's Answer and continuing on through the first full paragraph on page 5. The foregoing three paragraphs are a paraphrasing of a portion of the final rejection as quoted in the three full paragraphs starting near the top of page 12 of Appellants' Brief. Appellants answered the Examiner's foregoing rejection starting at the second last line on page 12 of Appellants' Brief and continuing on through the first full paragraph on page 14 of Appellants' Brief.

On page 5 of the Examiner's Answer the Examiner responded to appellants' arguments. In this response the Examiner stated:

"Applicant argues that Tuma does not teach the limitations of a 'first basic salt being primarily associated with said adsorbent, and said second basic salt being primarily associated with said binder'. However, it is the examiner's position that no criticality is seen in the particular limitations. There are no unusual and/or unexpected results, which

would rebut prima facie obviousness since Tuma teaches an adsorbent article useful for the same purpose, e.g., shaped adsorbent articles used in electronic devices for absorbing acid gas, filtering fluid and air (see abstract, columns 1 and 9)."

Appellants answered the foregoing lack of criticality matter starting toward the bottom of page 9 of Appellants' Brief as follows:

"In answer to this, it is submitted that the criticality is as expressed in the specification, namely, the second basic salt mixes more readily with the binder than if only one salt was mixed with the adsorbent and the binder, and the second basic salt not only absorbs the acid-gas but also absorbs the acid-gas which was adsorbed and desorbed from the binder. It is submitted that this concept of the use of the second basic salt associated with the binder is not taught in the Tuma patent nor is there any reasonable suggestion therein that a second basic salt should be primarily associated with the binder."

On page 6 the Examiner continued on with an answer to appellants' arguments as follows:

"Applicant argues that it would not have been obvious for one of ordinary skill in the art to modify Tuma's adsorbent article to produce the composition wherein a first basic salt being primarily associated with the adsorbent, and said second basic salt being primarily associated with the binder. In response to applicant's argument, no criticality in the mixing steps since the prior art teaches the method of making an acid-gas absorbing tablet for the same purpose using the same ingredients. The burden is shifted to applicant to establish some criticality in the order of mixing. There are no ratios and/or percentages set forth that impact a distinction over the process disclosed by the prior art. Note that claim 34 clearly acknowledges that any proportions may be used."

The following statement in the Examiner's above-quoted Answer is inaccurate "In response to applicant's argument, no criticality in the mixing steps since the prior art teaches the method of making an acid-gas absorbing tablet for the same purpose using the same ingredients." It is not

seen where the Tuma patent "...teaches the method of making an acid-gas absorbing tablet for the same purpose using the same ingredients." The Tuma patent definitely does not teach the first basic salt primarily associated with the adsorbent and the second basic salt being primarily associated with the binder, as recited in claims 3 and 7. Also, Tuma does not teach the limitations of claim 28 wherein (1) an adsorbent and a first basic salt are blended to produce a first mixture and (2) a binder and a second basic salt are blended to produce a second mixture and (3) blending the first and second mixtures. Also, Tuma does not teach the limitations of claim 38 of an acid-gas absorbing tablet comprising a first blended mixture of at least one adsorbent and a basic salt, a second blended mixture of a binder and a second basic salt, and a blended mixture of the first and second blended mixtures. Also, Tuma does not teach the limitations of claim 39 wherein the acid-gas absorbing tablet is set forth in means plus function format.

After stating that Tuma teaches the lack of criticality in the mixing steps, the Examiner stated "The burden is shifted to applicant to establish some criticality in the order of mixing." It is submitted that this criticality was clearly demonstrated by appellants and discussed in Appellants' Brief starting at the end of page 9 wherein it was specifically stated that the criticality is that "...the second basic salt mixes more readily with the binder than if only one salt was mixed with the adsorbent and the binder, and the second basic salt not only absorbs the

acid-gas but also absorbs the acid-gas which was adsorbed and desorbed from the binder." It is submitted that the burden is not shifted to applicant to establish some criticality in the order of mixing, as stated by the Examiner, but the burden is on the Examiner to show that Appellants' claimed subject matter is obvious, as required by 35 USC 103, in order to constitute a valid rejection.

In the above-quoted paragraph of the Examiner's Answer, the Examiner further stated "There are no ratios and/or percentages set forth that impact a distinction over the process disclosed by the prior art." It is submitted that "ratios and/or percentages" are not required in the broader claims discussed above, considering that the limitations of these broader claims are not obvious from the Tuma patent, as required by 35 USC 103 for a valid rejection.

The Examiner further, in response to Appellants' arguments, stated as follows:

"While the generic claims claimed the particular limitation, dependent claims 4, 5, 10, 11, 29, 32, 35, 41, 42, 44 and 45 recited first and second basic salts can be selected from the same salt groups, such as, sodium and potassium carbonates or bicarbonates. Although there are dependent claims that recited first acid salt is selected from the carbonates salt group, and second acid salt is selected from the bicarbonates salt group, applicant's specification at page 5 disclosed potassium carbonate or any other suitable basic salt (first basic salt) may be used with the binder. Accordingly, no criticality is seen in the limitation of first basic salt is associated with the adsorbent, and second basic salt is associated with the binder."

It is submitted that the criticality reflected in the claims is the separate mixing of the first basic salt with the adsorbent and the separate mixing of the second basic salt

with the binder which results in the first basic salt being primarily associated with the adsorbent and the second basic salt being primarily associated with the binder. This is because the separate mixings cause a more intimate association with each of the adsorbent and the binder than if there was a general mixing of a single salt with the adsorbent and the binder, as in the Tuma patent. Thus there are situations where the first and second basic salts may be the same but, in the sense of the claims, the first basic salt is different from the second basic salt in that the first basic salt is mixed with the adsorbent and the second basic salt is mixed with the binder before the two mixtures are mixed together.

CONCLUSION


In view of the foregoing remarks it is submitted that the final rejection of claims 3-7, 10-12 and 28-46 be reversed.

Three copies of this Reply Brief are being submitted.

Respectfully submitted,

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